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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/714,283	11/14/2003	Eric Garland	34443.3	2048
27683	7590	07/02/2004	EXAMINER	
HAYNES AND BOONE, LLP 901 MAIN STREET, SUITE 3100 DALLAS, TX 75202			RAYYAN, SUSAN F	
			ART UNIT	PAPER NUMBER
			2177	

DATE MAILED: 07/02/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

10/714,283

Applicant(s)

GARLAND ET AL.

Examiner

Susan F. Rayyan

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 15 November 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-34 is/are pending in the application.
- 4a) Of the above claim(s) 1-8, 17-23 and 31-34 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 9-16 and 24-30 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 11/15/04 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

**DETAILED ACTION**

***Election/Restrictions***

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:

Group I, Claims 1-8, 17-23, 31-34 is drawn to access augmentation or optimizing, classified in Class 707, subclass 2.

Group II, Claims 9-16, 24-30 is drawn to file or database management, classified in Class 707, subclass 200.

2. The inventions are distinct, each from the other because of the following reasons:

Inventions I and II are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable. In the instant case, invention in Group I has separate utility such as tracking and storing search requests. The invention in Group II has a separate utility such as tracking shared files. See M.P.E.P. § 806.05(d).

3. Because these inventions are distinct for the reasons given above and the search required for Group I is not required for the other Group, restriction for examination purposes as indicated is proper.

4. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.

5. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

6. A telephone call was made to William Hickman on June 16, 2004 to request an oral election to the above restriction requirement. An election was made to Group II, claims 9-16,24-30, without traverse.

7. An election, with or without traverse, must be made by the Applicant in replying to this Office Action.

8. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 C.F.R. § 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a diligently-filed petition under 37 C.F.R. 1.48(b) and by the fee required under 37 C.F.R. § 1.17(h).

***Information Disclosure Statement***

9. Information Disclosure Statement filed on May 24, 2004 has been considered.

***Claim Rejections - 35 USC § 102***

10. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

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(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

**11. Claims 9-12, 15-16,24--28 are rejected under 35 U.S.C. 102(e) as being anticipated by Dutta et al (Pub. No.: US 2002/0138471).**

**As per independent claim 9 Dutta anticipates:**

a computer coupled to the network at fig.4, paragraph 70;  
a database coupled to the computer at fig.4, paragraph 70 (client rating database);  
a query device adapted to request a library of shared files from a plurality of computers connected to the network at paragraph 59, lines 1-4;  
and a transfer device adapted to transfer the plurality of libraries of shared files from the computer to the database at paragraph 60, lines 1-4.

Dutta teaches a computer coupled to the network, a database coupled to the computer, a query device adapted to request a library of shared files from a plurality of computers connected to the network, and a transfer device adapted to transfer the plurality of libraries of shared files from the computer to the database at fig.4, paragraph 59, lines 1-4, paragraph 60, lines 1-4 and paragraph 70.

**As per claim 10 same as claim arguments above and Dutta anticipates:**

further comprising an inventory preparation server coupled to the database at paragraph 71(client ratings database).

**As per claim 11** same as claim arguments above and Dutta anticipates:  
further comprising an archiving system coupled to the database, the archiving system to store at least one copy of the plurality of libraries at paragraph 71(client ratings database).

**As per claim 12** same as claim arguments above and Dutta anticipates:  
further comprising an inventory processing server coupled to the database at paragraph 71.

**As per claim 15** same as claim arguments above and Dutta anticipates:  
the computer further comprising an interception device adapted to make a copy of a plurality of search requests from the network at paragraph 59.

**As per claim 16** same as claim arguments above and Dutta anticipates:  
the computer further comprising a second transfer device adapted to transfer the plurality of search requests from the computer to the database at paragraph 59.

**As per independent claim 24 Dutta anticipates:**  
coupling a computer to a database at fig.4, paragraph 70;  
coupling the computer to the network at fig.4, paragraph 70 (client rating database);  
locating a plurality of computers connected to the network by IP address at paragraph 71, lines 4-5;  
requesting a listing of a library of shared files from each of said plurality of computers connected to the network at paragraph 59, lines 1-4;  
and transferring the listing of the plurality of libraries of shared files from the computer to the database at paragraph 60, lines 1-4.

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Dutta teaches coupling a computer to a database, coupling the computer to the network, locating a plurality of computers connected to the network by IP address, requesting a listing of a library of shared files from each of said plurality of computers connected to the network, and transferring the listing of the plurality of libraries of shared files from the computer to the database at fig.4, at paragraph 59, lines 1-4, paragraph 60, lines 1-4, paragraph 70 (client rating database), and paragraph 71, lines 4-5.

**As per claim 25** same as claim arguments above and Dutta anticipates:  
further comprising adding source information to each of the listings at paragraph 71.

**As per claim 26** same as claim arguments above and Dutta anticipates:  
wherein the source information comprises the geographic location of a computer where the library is stored at paragraph 71.

**As per claim 27** same as claim arguments above and Dutta anticipates:  
further comprising intercepting a plurality of search requests on the network, where said plurality of search requests come to said computer, and copying said plurality of search requests at paragraph 59.

**As per claim 28** same as claim arguments above and Dutta anticipates:  
further comprising transferring the plurality of search requests from the computer to the database at paragraph 59.



***Claim Rejections - 35 USC § 103***

12. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

13. **Claims 13-14,29-30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dutta et al (Pub. No.: US 2002/0138471) in view of O'Kane (Pub. No.: US 2003/0105831).**

**As per claim 13-14** same as claim arguments above and Dutta teaches: further comprising an inventory preparation server coupled to the database, an inventory processing server coupled to the inventory preparation server at fig.4. Dutta does not explicitly teach a report preparation server coupled to the inventory processing server however O'Kane teaches this limitation at paragraph 62, lines 1-6 and paragraph 63. It would have been obvious to one of ordinary skill in the art at the time of the invention to combine the cited references to allow intellectual property owners a means to track royalties at paragraph 19, lines 1-4.

**As per claim 29-30** same as claim arguments above and Dutta does not explicitly teach generating at least one report including data from a plurality of listings and a plurality of search requests however O'Kane teaches this limitation at paragraph 62, lines 1-6 and paragraph 63. It would have been obvious to one of ordinary skill in the art at the time of the invention to combine the cited references to allow intellectual property owners a means to track royalties at paragraph 19, lines 1-4.

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**Conclusion**

14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Susan Rayyan whose telephone number is (703) 305-0311. The examiner can normally be reached M-F: 8am - 4:30pm.

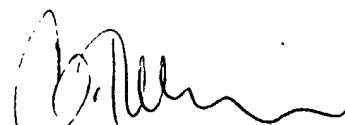
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Breene can be reached on 703-305-9790. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9306 for Official communications, (703) 746-7238 for After Final communications and (703) 746-7240 for Status inquiries and draft communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-3900.

Susan Rayyan



June 19, 2004



CHITRA ROBINSON  
PATENT EXAMINER